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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,874	04/19/2005	Ryuji Ueno	Q87423	5640

  

23373	7590	02/10/2011
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EXAMINER
POLANSKY, GREGG

  

ART UNIT	PAPER NUMBER
1614	

  

NOTIFICATION DATE	DELIVERY MODE
02/10/2011	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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FEB 09 2011

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In re Application of:

Ryuji Ueno

Serial No.: 10/531,874

Filed: April 18, 2005

Attorney Docket No.: Q87423

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: PETITION DECISION  
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This is in response to the petition under 37 CFR § 1.181, filed December 22, 2010, requesting that the finality of the Office action of October 22, 2010 be withdrawn because it was premature.

BACKGROUND

On March 7, 2010, the examiner mailed a non-final Office action setting a three month statutory limit for reply. At the time of this Office action, claims 1, 3-13, and 18, 19 and 21-25 were pending and claims 1, 3-10, 12, 13, 18, 19, 21 and 22 were rejected. The examiner rejected claims 3, 4, 6, 8, 10 and 18 under 35 USC 112, second paragraph, as indefinite. The examiner rejected claims 3, 4, 6, 8, 10 and 18 under 35 USC 112, first paragraph, as failing to comply with the written description requirement. The examiner rejected claims 1, 3-10, 12, 13, 18, 19, 21 and 22 under 35 USC 112, first paragraph, as non-enabling. Claims 11, 23 and 24 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. Claim 25 was allowed.

On August 9, 2010, applicant filed amendments to the claims and arguments traversing the examiner's rejections instituted in the non-final Office action of March 7, 2010.

On October 22, 2010, the examiner mailed a final Office action setting a three month statutory limit for reply. At the time of this Office action, claims 1, 5, 7, 11-13, 21 and 24-26 were pending and claims 1, 5, 7, 11-13, 21, 24 and 25 were rejected. The examiner rejected claims 1, 5, 7, 11-13, 21 and 24 under 35 USC 112, second paragraph, as indefinite. The examiner rejected claim 25 under 35 USC 112, first paragraph, as failing to comply with the written description requirement. The examiner rejected claims 1, 5, 7, 11-13, 21, 24 and 25 under 35 USC 112, first paragraph, as non-enabling. Claim 26 was objected to as being dependent upon a rejected base

claim, but would be allowable if rewritten in independent form. The examiner indicated that applicant's amendment necessitated the new grounds of rejection.

On December 22, 2010, applicant submitted the petition under consideration herein.

## DISCUSSION

The petition and the file history have been carefully considered.

In the petition, applicants argues "...the Examiner previously indicated that claim 23 was enabled (see page 5 of the May 7, 2010 Office Action), and Applicant notes claim 1 was amended in the August 9, 2010 Amendment to incorporate the compound of claim 23, as well as to make additional narrowing amendments with respect to the scope of that compound. That is, claim 23 was directed to a 15- keto-16-mono or dihalogen-prostaglandin E1 compound within the scope of formula (I) of previous claim 1, upon which claim 23 depended. Present claim 1 is directed to a 15-keto- 16- mono or dihalogen-prostaglandin E1 compound represented by formula (II), which is a subgenus of previous formula (I). Since previous claim 23 was enabled, Applicants submit that narrower present claim 1, which is within the scope of previous claim 23, should be enabled. However, since the Examiner has rejected it for lack of enablement, the rejection should be made in a non- final Office Action. Accordingly, Applicant submits that the finality of the present Office Action is improper and should be removed."

Applicant's argument has been accorded careful consideration and is persuasive since claim 23 was first rejected under 35 USC 112, first paragraph, in the final Office action of October 22, 2010. Accordingly, applicant's amendments did not necessitate the new rejection. MPEP § 706.07 recites:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

Thus, it is *not* proper for an office action to be made final when the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c).

## DECISION

The petition is subsequently **GRANTED**.

The Office action mailed October 22, 2010 is hereby vacated to the extent that it was made "final" and the Office action is now considered to be a non-final Office action. This application will be forwarded to the examiner to take an action consistent with the decision herein.

Should there be any questions about this decision please contact Quality Assurance Specialist Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 571-273-8300.



Remy Yucel  
Director, Technology Center 1600